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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,375	12/15/1999	JEAN-LOUIS GUERET	2350-76	3736
23117	7590	05/01/2006	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			CHOI, FRANK I	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/461,375

**Applicant(s)**

GUERET, JEAN-LOUIS

**Examiner**

Frank I. Choi

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/30/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4 and 7-26 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 7-9, 15 and 17-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4,7-9, 15, 17-26 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that said claims fail to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 5 filed 11/6/00 and Paper No. 17 (10/27/2003). In paper no. 5, applicant has stated the compositions contain no water and then in paper no. 17 modified it to substantially no water, and this statement indicates that the invention is different from what is defined in the claim(s) because the claims do not clearly indicate that they may not contain substantial amounts water. Examiner as duly considered Applicant's arguments but deems them unpersuasive for the reasons of record set forth in the prior Office Action (9/29/2005).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 7-9, 15, 17-22, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higo et al. (WO 96/16642) for the reasons of record set forth in the prior Office Actions in further view of Hori et al. (US Pat. 4,500,683) and the further reasons below.

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Higo et al. (WO 96/16642) (*English language equivalent, U.S. Pat. 5,866,157, for Applicant's convenience*) teach an adhesive containing a physiological active substance, organic acid, a hydrophobic high molecular material, a tackifying resin, plasticizer and absorption enhancer (Pg. 4, lines 9-14) (*Column 2, lines 45-53*). It is taught that the organic acids include lactic acid, maleic acid and salicylic acid (Pg. 4, lines 16-27) (*Column 2, lines 56-68*). It is taught that copolymers containing at least two materials selected from 2-ethylhexyl acrylate, vinyl acetate, methacrylate, methoxyethyl acrylate and acrylic acid are suitable as the hydrophobic high molecular material (Pg. 7, lines 4-14) (*Column 3, lines 64-68, Column 4, lines 4-8*). It is taught that absorption enhancers include geraniol, thymol, eugenol, terpineol, 1-menthol, bonreol, d-limonene, isoeugenol, isoborneol, nerol (Pg. 9, lines 7-26, Pg. 10, lines 1-15)(*Column 4, lines 60-68, Column 5, lines 1-22*). It is taught that the adhesive layer can contain antioxidants, fillers and ultraviolet absorbers, for example, tocopherol, ascorbic acid, calcium carbonate, magnesium carbonate, silicates, silicic acid, barium sulfate, calcium sulfate, calcium zincate, zinc oxide, titanic oxide and salicylic acid derivatives(Pg. 10, lines 23-26, Pg. 11, lines 1-25) (*Column 5, lines 33-63*). It is taught that the adhesive may be prepared by dissolving the base components containing drugs in a solvent such as ethyl acetate and the like and removing the solvent by drying (Pg. 12, lines 5-12) (*Column 6, lines 3-9*).

Hori et al. disclose that alkyl acrylate, acrylic acid, vinyl acetate pressure sensitive adhesives which provide high cohesive strength and high adhesive strength without using crosslinking agents, for example an adhesive strength of 840 g/20 mm and molecular weight greater than 100,000 (Column 1, lines 42-46, Columns 2, 3, Column 3, lines 5-43 ).

The difference between the cited reference and the claimed invention is that the prior art does not expressly disclose a colorless solution for cosmetic use, based on a hydrophobic polymer in an organic solvent medium selected from the group consisting of ethyl acetate, ethyl alcohol, isopropyl alcohol and mixtures thereof which contains at least one self-adhesive hydrophobic polymer which is of linear structure, non-ionic and non-water swellable and is selected from copolymers of the acrylic/vinyl type, at least one compound selected from the group consisting of a filler and an essential oil, and at least one keratolytic agent, said polymer having an adhesiveness of between 150 and 800 g/square centimeter after evaporation of said organic solvent medium. However, the cited reference amply suggests the same as it is known in the art to combine various components into vinyl/acrylic copolymer adhesives including cosmetic compounds, organic acids, fillers and essential oils. As such, it would have been well within the skill of one of ordinary skill in the art to modify the prior art as above with the expectation that the pharmaceutical incorporated therein would be absorbed faster and the formulation would exhibit extremely reduced skin irritation (Higo, Pg. 12, line 26, Pg. 13, lines 1-6) (Higo, *Column 6, lines 29-38*). Further, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to prepare said adhesives having varying strength and molecular weight as desired to provide sufficient support and adhesiveness for transdermal patch and active ingredients.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

The claims are amended indicated instantaneous cleansing or care properties. However, said limitation is directed to the intended use of the claimed composition. In response to applicant's arguments, the recitation "instantaneous" has not been given patentable weight

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because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951).

Applicant argues that Higo differs from the solution of the presently claimed invention at least by the absence of an organic solvent. However, Applicant's claims specifically indicate the use of an organic solvent which is evaporated and Higo discloses the use of an organic solvent which is also evaporated. Further, Higo in combination with Hori et al. suggest the self-adhesive hydrophobic copolymer as indicated above.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

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***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Sreeni Padmanabhan, can be reached at (571)272-0629. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FIC

April 27, 2006



**SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER**